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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,557	11/02/2001	E-Lee Chang	36968/262344	5022
23552	7590	03/21/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DIEP, NHON THANH	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/003,557	Applicant(s) CHANG ET AL.	
	Examiner Nhon T. Diep	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/02; 5/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention II consisting of claims 15-35 in the reply filed on 1/10/2006 is acknowledged.

Applicant's election with traverse of claims 15-35 in the reply filed on 1/10/2006 is acknowledged. The traversal is on the ground(s) that both groups are closely related and that they would not be a serious burden for the Examiner to examine all the claims at this time. This is not found persuasive because claims 1-14 drawn to a system for recording a digital video image, classified in class 725, subclass 105, which are not a compressed video signals while claims 15-35, drawn to a method for compress video image, classified in class 375, subclass 240.01. There is a clear difference on the method and apparatus in the process of compressed and un-compressed signals and the inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 1806.04, MPEP 1808.01). In the instant case the different inventions of Group I does not involve the compression of video signals as required by the invention of group II. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the

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search required for Group I is not required for Group 11, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoffberg (US 6,791,472).

Hoffberg discloses a mobile communication device comprising the same method for recording a digital video image comprising: capturing a video image on a video-capture device (fig. 1, camera 26); compressing said digital video image to create a compressed image file (col. 24, ln. 45-47 and col. 31, ln. 37-42); transmitting said compressed image file over a wireless transmission channel (fig. 1, from camera 26 to tower 10'); and retransmitting said

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compressed image file over a packet network to a security office (network communication 24) as specified in claim 15.

Re claim 16: The video-capture device comprises a cellphone (col. 23, In. 1).

Re claim 17: The video-capture device comprises a personal digital assistant (col. 23, In. 2-6).

Re claim 18: The video-capture device comprises: a video camera; and a wireless modem (fig. 1, camera 26).

Re claim 19: wherein the transmission channel comprises a long-range transmission channel (from camera 26 to tower 10').

Re claim 20: The determining an origin of said digital video image; and transmitting said origin with said compressed image file (col. 1, In 39-42 and col. 25, In. 49-65).

Re claim 21: The determining comprises determining said origin using a GPS receiver (col. 3, In. 12-29).

Re claim 22: The determining comprises determining said origin using a cell identifier in a cellular network (col. 18, In. 33-36).

Re claim 23: The determining comprises determining said origin using an E-911 service (col. 18, In. 33-36).

Re claim 24: further comprising receiving said compressed image file in a secure remote location (fig. 1, el. 20, 25).

Re claim 25: The receiving said compressed image file in the security office (fig. 1, el. 20, 25).

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Re claim 26: The viewing said compressed image file (fig. 1, el. 25).

Re claim 27: The storing said compressed image file (fig. 1, el. 20).

Re claim 28: the forwarding said compressed image file (from el. 24 to el. 25 to el. 20).

Re claim 29: The notifying a governmental agency (col. 18, ln. 33-36).

Re claims 30-31: The determining an identity of a user associated with said digital video image; and transmitting said identity with said compressed image file and the determining comprises receiving a user identification number (at least in a situation where a cellular telephone position detection system is employed, the holder of the cellular phone, which has an unique identification number is considered "an identity of a user associated with said digital video image" and the ID is always transmitted and as always known by the service provider).

Re claim 32: The determining comprises using authentication (col. 31, ln. 66 – col. 32, ln. 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffberg.

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As applied to claim 30 above, it is noted that Hoffberg does not particularly disclose: The associating comprises searching a user-profile database and the user-profile database comprises a telephone service provider's subscriber database as specified in claims 33-34. Hoffberg does suggest "One way to subsidize a subscription-based system is through advertising revenue. Therefore, the "events" may also include messages targeted to particular users, either by location, demographics, origin, time, or other factors. Thus, a motel or restaurant might solicit customers who are close by (especially in the evening), or set up transponders along highways at desired locations. Travelers would then receive messages appropriate to time and place. While the user of the system according to the present invention will typically be a frequent motorist or affluent, the system may also provide demographic codes, which allow a customized response to each unit. Since demographic information is personal, and may indicate traveler vulnerability, this information is preferably not transmitted as an open message and is preferably not decodable by unauthorized persons. In fact, the demographic codes may be employed to filter received information, rather than to broadcast interests (col. 25, ln. 49-65), which is the same as using user-profile information (particular users) to advertise (a motel or restaurant). And therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to store and to retrieve a user-profile with a telephone service provider's subscriber database. Doing so would help to generate revenue through advertisement.

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6. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffberg.

As applied to claim 1 above, it is noted that Hoffberg does not particularly disclose the billing for provision of said service. Stewart et al (6,259,405) teaches "To provide user identification and/or ensure security, the MU may also be equipped with a code generator that generates an identification code that may be transmitted to and recognized by the wireless AP 120. This identification code may then be relayed to different service providers 140 and/or MIB 150 that are coupled to wireless AP 120 via centralized network 130. Such an identification code may utilize recognition of a MU before providing access to system services, thereby providing a measure of security and a service billing mechanism. The identification code may also identify the user to enable a service provider to use known information regarding the user or view demographic information in conjunction with the known geographic location to provide specific information (e.g., advertising) to the user." (col. 6, ln. 49-63). And therefore, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the system of Hoffberg by providing a billing system as taught by Stewart et al. Doing so would help to improve the system before the system can be used for business.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Tran (US 6,202,060) discloses a data management system.

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b. Hanson (US 6,868,074) discloses a mobile device and method of locating mobile data device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T. Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ND
3/18/2006


**NHON DIEP
PRIMARY EXAMINER**